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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,485	12/28/2001	Jong-Uk Choi	01122-1000	2206
30671 7590 04/27/2007 DITTHAVONG MORI & STEINER, P.C. 918 Prince St. Alexandria, VA 22314			EXAMINER BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/034,485	Applicant(s) CHOI ET AL.	
	Examiner Bradley B. Bayat	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) 20-23, 27-38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of claims 24, 25, 26 and 39 in the reply filed on January 26, 2007 is acknowledged. The Examiner thanks the Applicant for illustrating and separating the claims by claim tree to clarify the groups. The traversal is on the ground(s) that there would be no serious burden on the examiner to conduct the search and therefore examination of all pending claims since the groups substantially overlap. This is not found persuasive because Applicants failed to argue that the groups of Inventions are not patentable distinct. An example will help illustrate the Examiner's point.

First, suppose two hypothetical groups of Inventions—Group A (claims 1-9) and Group B (claims 10-20)—each having claims 1 and 10 respectively as their only independent claims. Next, suppose that all the claim elements in Group A can be summarized as E_A . Supposed that Group B contains some of the claim elements from Group A (*i.e.* E_A) and some additional elements not found in Group A, *i.e.*, E_B . Therefore Group B could be summarized as having both $E_A + E_B$ claim elements.

In a first scenario, if we agree that Group A *is not patentably distinct* from Group B (*i.e.*, claim 1 is not patentably distinct from claim 10), the Examiner agrees that a restriction is improper. See MPEP §§ 810 and 808.02. This makes sense because in this first scenario, suppose an examiner sets forth an erroneous restriction which ultimately results in a divisional application. However, in such a case, an obvious non-statutory double patenting rejection is proper since we agreed (by definition) that claims 1 and 10 are not patentable distinct. However the erroneous restriction would bar the double patenting rejection causing a chaotic situation.

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Without the restriction and because claims 1 and 10 are not patentably distinct, the obvious non-statutory double patenting rejection is proper. See MPEP §804 II B. 1.

In a second scenario, if we agree that Group A *is patentably distinct* from Group B (*i.e.* claim 1 is patentable distinct from claim 10), a restriction is proper. And by definition, there can be no double patenting. However because of the mandatory electronic searches required for allowance in class 705,¹ the examiner would be *required* to search for patentably distinct features E_B—even if Group A (*i.e.* E_A) was searched and considered allowed. This additional search is *prima facie* evidence to support a restriction. See MPEP §808.02 (C).

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-23, 27-38 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/26/2007.

Status of Claims

Claims 20-40 remain pending. Claims 20-23, 27-38 and 40 are withdrawn from consideration as noted above. Claims 24, 25, 26 and 39 are presented for examination on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

¹ See *Notification of Required and Optional Search Criteria for Computer Implemented Business Method Patent Applications in Class 705, and Request for Comments*, Federal Register, Vol. 66, No. 108, 30167, June 5, 2001.

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24, 25, 26, and 39 rejected under 35 U.S.C. 102(e) as being anticipated by

Fransdonk, US 2006/0210084 A1.

Fransdonk discloses:

24. (Previously Presented) A method for providing security, the method comprising:

creating a unique user key using system information of a user terminal; and

transmitting digital information and user information including the unique user key to a server

system via a network, wherein the unique user key is transmitted by a user application tool

installed in the user terminal for authentication [0105, 126, 146, 183, 202, 210-221].

25. (Previously Presented) The method according to claim 39, wherein the rule includes one or

more of authority of storage, authority of print, authority of allowable time for use, or authority

of transfer of the data [0235, 238, 252-263, 273-295].

26. (Previously Presented) The method according to claim 24, wherein the system information

includes at least one of unique CPU (Central Processing Unit) information, RAM (Random

Access Memory) information, HDD (Hard Disk Drive) information, or serial number

information of the user terminal [0105-107, 146, 162].

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39. (Previously Presented) The method according to claim 24, further comprising: encrypting data and the user information including the unique user key transmitted from the user terminal; storing the encrypted user information and the encrypted data in the server system; establishing a rule corresponding to the user information and the data; encrypting the rule and a decryption key for decrypting the digital information using the unique user key; combining the encrypted data, the encrypted rule and the encrypted decryption key into combined information; storing the combined information; performing a user authentication process by comparing the unique user key stored in the server with the unique user key subsequently transmitted from the user application tool of the user terminal for authentication; transmitting the combined information from the server system to the user application tool via the network after completing the user authentication process, when the user terminal requests a download of the data; and determining, with the user application tool, whether the data should be decrypted by determining whether the key used for encrypting the decryption key matches the unique user key created by the user application tool (see Figs. 8A, 8B, 9, 18 and associated text; 0047-0066, 0071-88, 0107, 0113, 0122).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references

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as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Bradley B. Bayat", with a stylized horizontal line extending from the end of the signature.

Bradley B. Bayat
Primary Examiner
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